

## REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 3 and 26 are requested to be canceled without prejudice or disclaimer.

Claims 1, 5, 7-10, 12-19, 21, 24-25 and 27 are currently being amended.

Claims 28 and 29 are being added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1, 4-10, 12-25 and 27-29 are now pending in this application.

### **Rejections under 35 U.S.C. § 112**

Claims 1-10 and 12-27 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner argues that various portions of claim 1 and corresponding portions of independent claims 10, 14 16-19 and 27 are unclear. Applicant has amended claims 1, 10, 14, 16-19 and 27 to more clearly recite various features. Accordingly, Applicant respectfully requests these rejections to be withdrawn.

### **Rejections under 35 U.S.C. § 101**

Claims 10, 12, 13, 17, 18 and 27 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Examiner argues that “the network element only comprises software and therefore the claims may be limited to strictly software ....” Office Action dated October 2, 2008, Page 4. While Applicant disagrees with the Examiner’s position, Applicant believes the amendments to the claims render this rejection moot. For example, claim 10 has been amended to recite “a storage medium embodying computer-executable instructions ....” Thus, the claims recite a tangible and physical computer readable medium.

As noted in M.P.E.P. § 2106.01, “[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases....” Further, computer programs “embodied in tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103.” In re Beauregard, 53 F.3d 1583 (Fed.Cir. 1995). Accordingly, Applicant request that the rejection of the claims under 35 U.S.C. § 101 be withdrawn.

### **Rejections under 35 U.S.C. § 103**

Claims 1, 3-10, 12-21 and 23-27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,438,124 to Wilkes *et al.* (“Wilkes”). Applicant respectfully traverses this rejection for at least the following reasons.

As noted in a previous reply, embodiments of the present invention provide a gateway between a circuit-switched network, such as a public switched telephone network (PSTN), and the Internet. The gateway of the embodiments of the present invention functions as a transmission node of the network and, accordingly, may be transparent to a user. Rather than the user, it is the PSTN which decides to utilize the gateway for routing certain calls. The users are not involved in the decision. In accordance with certain embodiments, a header in an IP protocol datagram determines whether or not the datagram includes information belonging to a specified channel in a corresponding time slot of a circuit switched network node. Accordingly, amended claim 1 recites “forming a header for said IP protocol datagram based at least partly on circuit switched channel identifying parameters....” Independent claim 10 recites a similar feature.

Wilkes fails to teach or suggest at least this feature. As noted by Applicant in a previous reply, Wilkes relates to a VoiceEngine device that functions between a PSTN and the Internet. In contrast to the gateway of the embodiments of the present invention, the device of Wilkes acts as a terminal. For example, in accordance with the disclosure of Wilkes, a telephone user may identify and make a call to the VoiceEngine. Thus, the user personally knows that, by dialing a specific number and making a call to the VoiceEngine, he gains access to certain advantages of further routing his call. Thus, unlike embodiments of the present invention, Wilkes discloses a device that is not transparent to the user.

In the Response to Arguments section of the pending Office Action, the Examiner cites Wilkes as disclosing “forming a header for said IP protocol datagram based at least partly on circuit switched channel identifying parameters” in Figure 2. Applicant respectfully disagrees with the Examiner’s interpretation of the disclosure of Wilkes as applied to the pending claims.

Specifically, in accordance with the disclosure of Wilkes, the line that leads from the receiving VoiceEngine (34) to the PSTN (31) is a single extension line. This single line has no channels and, therefore, does not require any channel identification parameters. Applicant respectfully notes that this is analogous to a line which connects any conventional landline telephone to the PTSN. Since such lines have no channels since they correspond to a single extension line. The only identifier is the telephone number associated with that line. There is no teaching or suggestion in Wilkes related to using such an identifier (telephone number) for composing IP packet headers.

Further, claim 1, as amended, recites “indicating within said IP protocol datagram separately for each of a plurality of time slots known to at least one of said first and second circuit switched network nodes, whether the IP protocol datagram carries data belonging to a channel corresponding to the time slot ....” Wilkes fails to teach or suggest this feature.

In accordance with the disclosure of Wilkes, a whole packet is always used for only one telephone connection. Even the Examiner interprets the disclosure of Wilkes as teaching that “each packet sent by the VoiceEngine contains a header that identifies which voice connection the packet belongs.” Office Action dated October 2, 2008, Page 7. Further, in accordance with the disclosure of Wilkes, the circuit switched line that comes to or goes from the VoiceEngine is a single telephone extension line and, therefore, does not require any time slot structure. Thus, Wilkes fails to teach or suggest anything associated with time slots corresponding to any indications.

Still further, claim 1 recites “when it is indicated that the IP protocol datagram does not carry data belonging to a channel, the second circuit switched network node is allowed to receive data to that channel from other sources from an IP-network in a non-consecutive manner.” Wilkes also fails to teach or suggest this feature.

In accordance with the disclosure of Wilkes, if a voice-carrying IP protocol datagram arrives at a receiving VoiceEngine, the voice signal must be carried on the telephone line. There is no possibility in the system of Wilkes of an IP protocol datagram that would not carry data and would thus allow the receiving VoiceEngine to receive data to some channel from other sources.

Thus, Wilkes fails to teach or suggest at least the above-noted features of the pending claims. Further, no other reference cited by the Examiner teaches or suggests these features. Thus, the Office Action fails to establish a *prima facie* case of obviousness.

Accordingly, independent claims 1 and 10 are patentable. Claims 4-9, 12-25 and 27 each depend, either directly or indirectly, from one of allowable claims 1 or 10 and are, therefore, patentable for at least that reason, as well as for other patentable features when those claims are considered as a whole.

#### **New Claims**

Claims 28 and 29 have been added to recite additional aspects of the invention. Support for the subject matter of claims 28 and 29 may be found in the originally filed specification and drawings. No new matter is introduced. Further, claims 28 and 29 are believed to be patentable for reasons similar to those noted above.

#### **Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely

acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: January 2, 2009

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